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EXAMINER

ROSWELL, MICHAEL

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/837,047

Applicant(s)

SANDERS ET AL.

Examiner

Michael Roswell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 August 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Drawings***

1. The drawings were received on 20 August 2001. These drawings are acceptable.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4 and 16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "user generated data items" (Page 6, Line 6), does not reasonably provide enablement for a "dynamic data item generator" (Page 23, Line 14 and Page 25, Line 21). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

4. In regards to claim 4, the claimed invention includes a "dynamic data item generator" that remains undisclosed in the specification. The specification includes the use of "user generated data items", but does not define any relationship between dynamic data and user generated data and does not serve to equate the two terms.

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5. In regards to claim 16, the claimed invention includes a "dynamic data item generator" that remains undisclosed in the specification. The specification includes the use of "user generated data items", but does not define any relationship between dynamic data and user generated data and does not serve to equate the two terms.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In regards to claim 4, Applicant describes an invention "wherein the data source consists of two or more selected from the group consisting of a database, a record source, a dynamic data item generator, and combinations thereof". Applicant fails to particularly point out and distinctly claim the subject matter due to redundancy in the claim language caused by the phrase "and combinations thereof."

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowden et al. (U.S. Patent No. 5,801,703).

11. In regards to claim 1, Bowden et al.'s Figure 3 clearly illustrates a first control operating within the graphical user interface, wherein "selection of the icon of a particular menu panel expands that menu panel" (Column 3, Lines 29-30). Bowden et al. go on to state, "the expanded menu panel includes one or more tools, features, or selections identified by the menu option associated with the corresponding contracted menu option panel" (Column 3, Lines 37-39). Bowden et al. also state, "in operation, a user can select tools and options from the different expanded menu panels, as needed..." (Column 6, Lines 12-13). In this instance, the Examiner interprets the Applicant's claimed "data items" as being analogous to menu items such as tools, features, or selections.

12. In regards to claim 2, Bowden et al. disclose, "thereafter, processor **108** (Figure 2) accesses a menu list data definition stored in memory **107**. The menu list defines menu options and corresponding tools for the expanded menu panel" (Column 6, Lines 39-42). In this instance Bowden et al.'s disclosed memory is analogous to Applicant's claimed "data source".

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13. In regards to claim 10, Bowden et al.'s Figure 4 illustrates the selection and modification of a group of multiple data items, in this case data relating to the group "Color" (item **312**). Bowden et al. also state, "in operation, a user can select tools and options from the different expanded menu panels, as needed, without the selection causing tools to disappear" (Column 6, Lines 12-14).

14. In regards to claim 12, Bowden et al.'s Figure 3 clearly illustrates a first control operating within the graphical user interface, wherein "selection of the icon of a particular menu panel expands that menu panel" (Column 3, Lines 29-30). Bowden et al. go on to state, "the expanded menu panel includes one or more tools, features, or selections identified by the menu option associated with the corresponding contracted menu option panel" (Column 3, Lines 37-39). Bowden et al. also state, "in operation, a user can select tools and options from the different expanded menu panels, as needed..." (Column 6, Lines 12-13). In this instance, the Examiner has chosen to interpret the Applicant's claimed "data items" as being analogous to menu items such as tools, features, or selections. Please take note of item **312** of Figure 4, where Bowden et al. illustrate a second control with a plurality of modifiable data items.

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowden et al. and Balint et al. (U.S. Patent No. 5,542,024).

17. In regards to claim 3, Bowden et al. have been shown to teach a method similar to Applicant's method in claim 1 (See ¶ 11), depicting a method for the modification of a data list by a user within a graphical user interface.

18. While Bowden et al. teach such a method, the reference fails to incorporate the use of a data source wherein said data source is a database.

19. Balint et al., however, teach the use of a database as a data source, as shown in Figure 1, Item 12 and Figure 2.

20. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to incorporate the teachings of Balint et al. into those of Bowden et al. By utilizing a control such as Balint et al.'s into Bowden et al.'s method of a modifiable graphical user interface, one would obtain a modifiable graphical user interface wherein the modified data list is stored in a database.

21. The motivation to do so being given by Balint et al., who in addition to Figure 1, Item 12 and Figure 2 state, "FIG. 3 is a representative example of a typical user screen using the operating system and database manager illustrated in FIG. 2" (Column 4, Lines 38-40). Further motivation is given by Balint et al., who also state, "a directive to retrieve, edit, update, add, or delete a record in the database is formulated by the

database interface module 14 [of Figure 1]" (Column 7, Lines 14-16).

22. Claims 5, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowden et al. and Goddard et al. (U.S. Patent No. 5,867,157).

23. In regards to claim 5, Bowden et al. have been shown to teach a method similar to Applicant's method in claim 1 (See ¶ 11), depicting a method for the modification of a data list by a user within a graphical user interface.

24. While Bowden et al. teach such a method, the reference fails to incorporate a step of adding a new data item to the list of items, as recited in the claims.

25. Goddard et al., however, teach the use of a control within a graphical user interface that has the functionality of adding a new data item to its data list, as shown in Figures 3 and 4. Goddard et al. also state, "Fig. 4 shows a typical window 70 to demonstrate how values are added to the list box" (Column 5, Lines 35-36).

26. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to incorporate the teachings of Goddard et al. into those of Bowden et al. By utilizing a control such as Goddard et al.'s into Bowden et al.'s method of a modifiable graphical user interface, one would obtain a modifiable graphical user interface capable of adding items to the data list from within the second control.

27. The motivation to do so being given by Goddard et al., who state, "In addition to creating the list, the user typically wants to modify the list, once created, by adding, deleting, or modifying values or certain components of values" (Column 2, Lines 61-65).



Further motivation is given by Bowden et al.: "each menu option has associated with it tools or features to control some aspect of an application or system" (Column 5, Lines 43-45).

28. In regards to claim 6, Bowden et al. have been shown to teach a method similar to Applicant's method in claim 1 (See ¶ 11), depicting a method for the modification of a data list by a user within a graphical user interface.

29. While Bowden et al. teach such a method, the reference fails to incorporate a step of deleting a data item from the list of items, as recited in the claims.

30. Goddard et al., however, teach the use of a control within a graphical user interface that has the functionality of deleting a data item from its data list, as shown in Figure 3. Goddard et al. also state, "the user also can delete a value in the list box 52 (Figure 4). To delete a value, the delete pushbutton 68 is selected" (Column 6, Lines 20-22).

31. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to incorporate the teachings of Goddard et al. into those of Bowden et al. By utilizing a control such as Goddard et al.'s into Bowden et al.'s method of a modifiable graphical user interface, one would obtain a modifiable graphical user interface capable of deleting items from the data list from within the second control.

32. The motivation to do so being given by Goddard et al., who state, "In addition to creating the list, the user typically wants to modify the list, once created, by adding, deleting, or modifying values or certain components of values" (Column 2, Lines 61-65).

Further motivation is given by Bowden et al.: "each menu option has associated with it tools or features to control some aspect of an application or system" (Column 5, Lines 43-45).

33. In regards to claim 7, Bowden et al. have been shown to teach a method similar to Applicant's method in claim 1 (See ¶ 11), depicting a method for the modification of a data list by a user within a graphical user interface.

34. While Bowden et al. teach such a method, the reference fails to incorporate a step renaming data items in the list of items, as recited in the claims.

35. Goddard et al., however, teach the use of a control within a graphical user interface that has the functionality of modifying a data item in its data list, as shown in Figure 6. Goddard et al. also state, "as shown in Fig. **6B**, minor modifications can be made to the delivery address component 58, the job copies component **60**, and the comment box **72**" (Column 5, Lines 65-67). It is well known in the art that such textual modifications as presented by Goddard et al. span such fields as renaming items.

36. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to incorporate the teachings of Goddard et al. into those of Bowden et al. By utilizing a control such as Goddard et al.'s into Bowden et al.'s method of a modifiable graphical user interface, one would obtain a modifiable graphical user interface capable of renaming (or modifying) items in the data list from within the second control.

37. The motivation to do so being given by Goddard et al., who state, "In addition to creating the list, the user typically wants to modify the list, once created, by adding,

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deleting, or modifying values or certain components of values" (Column 2, Lines 61-65).

Further motivation is given by Bowden et al.: "each menu option has associated with it tools or features to control some aspect of an application or system" (Column 5, Lines 43-45).

38. Claims 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowden et al. and Amin et al. (U.S. Patent No. 6,208,340).

39. In regards to claim 8, Bowden et al. have been shown to teach a method similar to Applicant's method in claim 1 (See ¶ 11), depicting a method for the modification of a data list by a user within a graphical user interface.

40. While Bowden et al. teach such a method, the reference fails to incorporate "a step for indicating a selection status of a selected data item."

41. Amin et al., however, disclose a method similar to Applicant's claimed invention. Amin et al.'s Figure 3 displays a control including a selection status indicator, in this case, a radio button. Amin et al. go on to state, "each of choices 56 in drop-down list 54 is preferably displayed with a graphical indication of whether or not that choice is currently selected" (Column 3, Lines 24-26).

42. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Amin et al. into those of Bowden et al. By utilizing a selection status such as Amin et al.'s radio button in Bowden et al.'s graphical user interface, one would obtain a control with means for indicating the selection status of a data item.

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43. The motivation to do so is given by Amin et al., who state, "the user is then permitted to select multiple choices from the drop-down list in response [to] the single selection of the drop-down widget" (Column 1, Lines 66-67 and Column 2, Line 1). Also, "the drop-down list includes a plurality of preferences that are each displayed in association with a respective control element, such as a radio button" (Column 4, Lines 8-9). Amin et al. express other possible embodiments wherein their selection status indicator is an object "such as a radio button 60 or a check mark" (Column 3, Line 29).

44. In regards to claim 9, Bowden et al. have been shown to teach a method similar to Applicant's method in claim 1 (See ¶ 11), depicting a method for the modification of a data list by a user within a graphical user interface.

45. While Bowden et al. teach such a method, the reference fails to incorporate a selection status element "proximate to the selected data item."

46. Amin et al., however, disclose a method similar to Applicant's claimed invention. Amin et al.'s Figure 3 displays a control including a selection status indicator proximate to a selected data item. Amin et al. go on to state, "the drop-down list includes a plurality of preferences that are each displayed with a respective control element, such as a radio button" (Column 2, Lines 2-3).

47. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Amin et al. into those of Bowden et al. By utilizing a selection status such as Amin et al.'s radio button in Bowden et al.'s graphical user interface, one would obtain a control with means for indicating the

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selection status of a data item wherein the selection status indicator is proximate to its relevant data item.

48. The motivation to do so is given by Amin et al., who state, "in response to a determination that the user has selected a choice within the drop-down list, the user's selection is visually indicated at block 84, for example, by highlighting, displaying a check mark adjacent to the choice label of the selected choice, or displaying a selection dot in a radio button" (Column 4, Lines 46-52).

49. In regards to claim 11, Bowden et al. have been shown to teach a method similar to Applicant's method in claim 1 (see ¶ 11) and claim 10 (¶ 13), depicting a method for the modification of a data list by a user within a graphical user interface.

50. While Bowden et al. teach such a method, the reference fails to incorporate a selection status element.

51. Amin et al., however, disclose a method similar to Applicant's claimed invention. Amin et al.'s Figure 3 displays a control including a selection status indicator proximate to a selected data item. Amin et al. go on to state, "the drop-down list includes a plurality of preferences that are each displayed with a respective control element, such as a radio button" (Column 2, Lines 2-3).

52. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Amin et al. into those of Bowden et al. By utilizing a selection status such as Amin et al.'s radio button in Bowden et al.'s

graphical user interface, one would obtain a control with means for indicating the selection status of multiple data items.

53. The motivation to do so is given by Amin et al., who state, "the user can advantageously select multiple choices following a single selection of the drop-down widget" (Column 4, Lines 56-57). Here Amin et al. describe the access of a second control through a first control, and the selection and indication of multiple data items (see Figure 3).

54. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowden et al. and Torres (U.S. Patent No. 5,317,687).

55. In regards to claim 13, Bowden et al. have been shown to teach a graphical user interface similar to Applicant's claim 12 (see ¶ 14), comprising a first control, second control, and a plurality of modifiable data items in said second control.

56. While Bowden et al. teach such a method, the reference fails to incorporate an "overview selection status box" that indicates whether any of the data items are selected when the second control is hidden from the user.

57. Torres, however, discloses a graphical user interface complete with an overview selection status box similar to Applicant's claimed invention (Figure 3 and Figure 4A-E).

58. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Torres into those of Bowden et al. By utilizing a representation of selections in a single graphical metaphor as described by Torres in combination with the graphical user interface of Bowden et al., one would

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obtain an interface including an overview selection status box similar to Applicant's claimed invention.

59. The motivation to do so is given by Torres, who states, "it is therefore one object of the present invention to represent a group of menu items in terms of a single graphical metaphor for that group" (Column 2, Lines 2-4). Torres gives further motivation when disclosing "an icon evocative of an arrangement of items permitting direct manipulation techniques for rearrangement of the group and selection of particular items from the group" (Column 2, Lines 10-14).

60. In regards to claim 14, Bowden et al. have been shown to teach a graphical user interface similar to Applicant's claim 12 (see ¶ 14), comprising a first control, second control, and a plurality of modifiable data items in said second control.

61. While Bowden et al. teach such a method, the reference fails to incorporate a "tri-state overview selection status box" that indicates whether any of the data items are selected when the second control is hidden from the user.

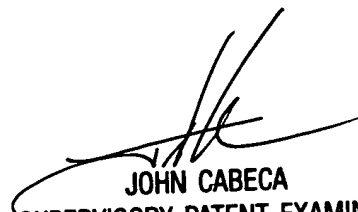
62. Torres, however, discloses a graphical user interface complete with an overview selection status box similar to Applicant's claimed invention, and capable of indicating multiple states (Figure 3 and Figure 4A-E).

63. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Torres into those of Bowden et al. By utilizing a representation of selections in a single graphical metaphor as described by Torres in combination with the graphical user interface of Bowden et al., one would

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obtain an interface including a tri-state overview selection status box or multi-state overview selection box similar to Applicant's claimed invention.

64. The motivation to do so is given by Torres, who states, "it is therefore one object of the present invention to represent a group of menu items in terms of a single graphical metaphor for that group" (Column 2, Lines 2-4). Torres gives further motivation when disclosing "an icon evocative of an arrangement of items permitting direct manipulation techniques for rearrangement of the group and selection of particular items from the group" (Column 2, Lines 10-14). Torres also discloses description of the many states of his representation when stating, "Fig. 4a depicts a situation where no options have been selected" (Column 4, Lines 17-18), "Fig. 4c depicts in pictorial form a situation where icon ring 48 is selected and one option from stack 54 has been selected" (Column 4, Lines 27-29), and "Fig. 4d depicts a situation where two options have been selected while the icon ring itself remains selected" (Column 4, Lines 34-35).



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